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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,403	11/26/2003	Jeffrey B. Lotspiech	ARC920030090US1	7944

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EXAMINER
WANG, HARRIS C

ART UNIT	PAPER NUMBER
2139	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/723,403	LOTSPIECH ET AL.
	Examiner	Art Unit	
	Harris C. Wang	2139	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 November 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-48* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-48* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>26 November 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All   b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date <u>11/26/2003</u>.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-48 are pending

Double Patenting

2.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11, 20, 28, 36 and 44 of copending Application No. 11009272 (See Claim Comparison Table below). Although the conflicting claims are not identical, they are not patentably distinct from each other because: Application 10723403 only differs from Application 11009272 in the

fact that 2nd application teaches delivering a permission to decrypt titles, and receiving

validation for the permission, and dividing the media into titles, whereas the 1st

application teaches delivering an encrypted encryption key, decrypting the encryption

key and dividing into parts.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to give permission by using an encrypted encryption key, validate by

decrypting said key and dividing into parts instead of titles.

The motivation is to provide a way of validating the keys.

The dependent claims are rejected as being obvious modifications of the

independent claims.

Claim Comparison Table

Application 10723403 (1st Application)	Application 11009272 (2nd Application)
1. A method for delivering multimedia content on a physical media, comprising: placing at least one media key block on the physical media; dividing the multimedia content on the physical media into multiple parts, each part being encrypted with a different encryption key; encrypting the encryption key with a key derived from the media key block; and delivering <u>the encrypted encryption key to a player of the physical media.</u>	1. A method of delivering multimedia content on a physical media, comprising: placing at least one media key block on the physical media; dividing the multimedia content on the physical media into a plurality of titles encrypted with one or more encryption keys; encrypting the encryption keys with a key derived from the media key block; and delivering <u>a permission to decrypt at least one of the titles to a player of the physical media.</u>

9. A method of playing a multimedia content on a physical media, comprising: identifying individual parts on the physical media; identifying a media key block on the physical media; receiving an encrypted encryption key; decrypting the encrypted encryption key using another encryption key derived from the media key block; and decrypting and playing one or more individual parts on the physical media.

17. A computer program product having instruction codes for delivering multimedia content on a physical media, comprising: a first set of instruction codes for placing at least one media key block on the physical media; a second set of instruction codes for dividing the multimedia content on the physical media into multiple parts, each part being encrypted with a different encryption key; a third set of instruction codes for encrypting the encryption key with a key derived from the media key block; and a fourth set of instruction codes for delivering the encrypted encryption key to a player of the physical media.

25. A computer program product of playing a multimedia content

11. A method of playing a multimedia content on a physical media, comprising: identifying individual encrypted titles on the physical media; identifying a media key block on the physical media; receiving a permission; validating the permission using an encryption key derived from the media key block; and decrypting and playing one or more individual titles on the physical media.

20. A computer program product having instruction codes for delivering multimedia content on a physical media, comprising: a first set of instruction codes for placing at least one media key block on the physical media; a second set of instruction codes for dividing the multimedia content on the physical media into multiple titles; a third set of instruction codes for preparing a permission based on a key derived from the media key block; and a fourth set of instruction codes for delivering the permission to a player of the physical media.

28. A computer program product of playing a multimedia content on a physical

on a physical
media, comprising: a first set
of instruction codes for
identifying individual
parts on the physical media; a
second set of instruction codes
for identifying
a media key block on the
physical media; a third set of
instruction codes for
receiving an encrypted
encryption key; a fourth set
of instruction codes for
decrypting the encrypted
encryption key using another
encryption key derived
from the media key block; and
a fifth set of instruction
codes for decrypting
and playing one or more
individual parts on the
physical media.

33.· A service for delivering
multimedia content on a
physical media,
comprising: a placement of at
least one media key block on
the physical media;
a division of the multimedia
content on the physical media
into multiple parts,
each part being encrypted with
a different encryption key; an
encryption of
the encryption key with a key
derived from the media key
block; and·a delivery
of the encrypted encryption key
to a player of the physical
media.

41. A service of playing a
multimedia content on a
physical media, comprising:

media, comprising: a first set
of instruction codes for
identifying individual
titles on the physical media;
a second set of instruction
codes for
identifying a media key block
on the physical media; a third
set of
instruction codes for receiving
a permission; a fourth set of
instruction
codes for validating the
permission using a encryption
key derived from the
media key block; and a fifth
set of instruction codes for
decrypting and
playing one or more individual
titles on the physical media.

36. A service for delivering
multimedia content on a
physical media,
comprising: a placement of at
least one media key block on
the physical media;
a division of the multimedia
content on the physical media
into multiple
titles; a permission
calculated based on a key
derived from the media key
block; and a delivery of the
permission to a player of the
physical media.

44. A service of playing a
multimedia content on a
physical media, comprising:
an identification of individual

an identification of individual parts on the physical media; an identification of a media key block on the physical media; a reception of an <u>encrypted encryption</u> key; a <u>decryption</u> of the encrypted encryption key using another encryption key derived from the media key block; and a decryption and playback of one or more individual parts on the physical media.	titles on the physical media; an identification of a media key block on the physical media; a reception of a <u>permission</u> key; a <u>validation</u> of the permission using an encryption key derived from the media key block; and a decryption and playback of one or more individual titles on the physical media.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

3.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 33-48 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The Applicant claims a "service" which is

neither a method, machine, manufacture or composition of matter or a new and useful

improvement thereof.

Claim Rejections - 35 USC § 102

4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-10, 12-14, 25-26, 28-30, 41-42 and 44-46 are rejected under 35

U.S.C. 102(b) as being anticipated by Pestoni's IMA talk titled "Content Protection for

Recordable Media" on Feb 16, 2001.

Regarding Claims 9-10, 12-14, 25-26, 28-30, 41-42 and 44-46

Pestoni teaches a method of playing a multimedia content on a physical media,

comprising:

identifying individual parts on the physical media, this step is inherent for playing

physical media.

identifying a media key block on the physical media; *(pg. 11, Process MKB)*

receiving an encrypted encryption key; *(pg. 11, E$_{Kmu}$(Kt) is sent to the Media*

Player)

. decrypting the encrypted encryption key using another encryption key derived

from the media key block; (pg. 11, Decrypt, *E$_{Kmu}$(Kt) using Kmu which was derived*

from the MKB)

and decrypting and playing one or more individual parts on the physical media.

(pg. 11, Decrypt to receive content). It is inherent that after the content is decrypted it is

fully capable of being played.

It is inherent that the encryption key is received over a network.

Pestoni further teaches wherein the encrypted encryption key is associated with

a price related to the playback of the part. *("Small fees associated with the keys and the*

MKBs" pg.10). It is inherent that the price is determined when the encrypted encryption

key is delivered.

Claim Rejections - 35 USC § 103

5.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 11, 27, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pestoni's IMA talk titled "Content Protection for Recordable Media" on Feb 16, 2001.

Pestoni teaches the method of claim 10. Pestoni does not explicitly teach wherein the delivery over the network involves a secure protocol; and further comprising placing necessary data for the secure protocol on the physical media.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make the delivery of the keys over the network involve a secure protocol and further comprising the physical media having necessary data for the secure protocol.

The motivation is that the delivery of keys requires security, where secure network transfers are well known in the art.

Claims 15-16, 31-32 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pestoni in view of Husemann (US 20050100161).

Pestoni teaches the method of claim 9. Pestoni does not explicitly teach further comprising associating the encrypted encryption key with a maximum price, and preventing playback once the maximum price is reached.

Huseman (Paragraph [0037]) teaches "the clearinghouse will charge the customer's registered credit card, encapsulate the requested content keys…and return the set of encapsulated keys."

It would have been obvious to one of ordinary skill in the art at the time of the invention to associate a maximum price with the key, and prevent playback once the maximum price is reached.

The motivation is that the server protects itself from those with bad credit history by assigning a maximum price, which the Examiner interprets as a credit limit, so that if there is no credit left, no transaction will take place.

Claims 1-5, 8, 17-21, 24, 33-37, 40 are rejected under 35 U.S.C. 103(a) as being.

being unpatentable over Pestoni's IMA talk titled "Content Protection for Recordable

Media" on Feb 16, 2001 in view of Akishita (Us 20020184259).

Regarding Claims 1, 17 and 33

Pestoni teaches a method for delivering multimedia content on a physical

media, comprising:

placing at least one media key block on the physical media *(pg. 11, the Figure*

shows the Media Key Block on the physical media);

encrypting the encryption key with a key derived from the media key block *(pg.*

11, $E_{Kmu}(Kt)$, where E_{Kmu} is the key derived from the media key block, and Kt is the

encryption key)

delivering the encrypted encryption key to a player of the physical media *(pg. 11,*

$E_{Kmu}(Kt)$ is shown being delivered to the player where it is decrypted.)

Pestoni does not teach dividing the multimedia content on the physical media

into multiple parts, each part being encrypted with a different encryption key. Akishita

teaches encrypting multiple sectors of a DVD with multiple content keys *(Fig. 27 a-b,*

"multiple content keys...serving as encryption keys corresponding to sectors...are encrypted

and stored in the security header configured corresponding to the contents" Paragraph [0489])

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Graunake to divide the physical media into multiple parts and encrypt each part with a different encryption key.

The motivation is to allow different parts of a physical medium to have multiple encryptions, instead of just having one key to encrypt the entire disc.

Regarding Claim 2, 18 and 34

Pestoni and Akishita teach the method of claim 1, wherein in CPRM inherently requires delivering the encrypted encryption key comprises delivery over a network.

Regarding Claims 3-5, 19-21 and 35-37 ·

Pestoni and Akishita the method of claim 1, wherein the encrypted encryption key is associated with a price related to the use of the part. Pestoni in Pg. 10 writes "small fees [are] associated with the keys and MKBs." It is inherent that the price is determined when the encrypted encryption key is delivered.

Regarding Claim 8, 24 and 40

Pestoni and Akishita teach the method of claim 2. Pestoni and Akishita do not explicitly

teach wherein the delivery over the network involves a secure protocol; and further

comprising placing necessary data for the secure protocol on the physical media.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to make the delivery of the keys over the network involve a secure protocol

and further comprising the physical media having necessary data for the secure

protocol.

The motivation is that the delivery of keys requires security, where secure

network transfers are well known in the art.

Claims 6-7, 22-23 and 38-39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pestoni and Akishita as applied to claim 1-5 above, and further in

view of Husemann (US 20050100161).

Regarding Claims 6-7, 22-23 and 38-39

Pestoni and Akishita teach the method of claim 3. Pestoni and Akishita do not

explicitly teach further comprising associating the encrypted encryption key with a

maximum price, and preventing playback once the maximum price is reached.

Huseman (Paragraph [0037]) teaches "the clearinghouse will charge the customer's registered credit card, encapsulate the requested content keys...and return the set of encapsulated keys."

It would have been obvious to one of ordinary skill in the art at the time of the invention to associate a maximum price with the key, and prevent playback once the maximum price is reached.

The motivation is that the server protects itself from those with bad credit history by assigning a maximum price, which the Examiner interprets as a credit limit, so that if there is no credit left, no transaction will take place.

Conclusion

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harris C. Wang whose telephone number is 5712701462. The examiner can normally be reached on M-F 8-5:30, Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AYAZ R. SHEIKH can be reached on (571)272-3795. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HCW

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3/13/07